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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,385	11/16/2000	Nicholas J. Rush	4862	8560

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EXAMINER

COBURN, CORBETT B

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 09/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,385

Applicant(s)

RUSH ET AL.

Examiner

Corbett B. Coburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to under 37 CFR 1.71 because it fails to provide details concerning the method of changing the odds of the games discussed in the specification (poker, roulette, blackjack, etc.) in order to insure that players receive a statistically positive token return. The specification also fails to disclose how a statistically positive token return can be guaranteed in sports betting.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 10, 11, 27, 28, 44 & 45 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

While the odds may be manipulated in some versions of video poker and slot machines, it is unclear how the odds of winning can be changed in the player's favor in blackjack, roulette, sports pools and books, keno, bingo, and solitaire. Applicant fails to disclose the method for changing these odds.

4. Claims 19 & 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The games described in the specification have a built-in bias toward the house. While it is possible to overcome this bias in slot machines and some versions of video poker, which determine the winner based on random numbers and display indicia accordingly, a method of changing the odds in a game with a human dealer is not disclosed.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-13, 16-30, 33-47 & 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingardt et al. (US Patent No. 5,275,400) in view of Walker et al. (US Patent No. 6086477). (Henceforth, Walker '477.)

Claims 1, 9, 20, & 37: Weingardt discloses a token account for tracking tokens associated with a player, (Col 7, 27-32) and a gambling apparatus coupled to the token account. (Col 7, 32-35) The apparatus is configured to debit or credit the token account based on the outcome of a gambling game. (Col 7, 43-49) There is a token conversion module for converting tokens according to a token value based on the total number of tokens in a set of tokens (i.e., pari-mutuel wagering). (Col 8, 3-10) Weingardt discloses a computer system for implementing his invention. (Col 7, 26)

Weingardt does not, however, teach the concept of a guaranteed win or statistically positive token return. Walker '477, an analogous invention, teaches that providing a guaranteed win increases participation in the game. (Col 3, 28-32)

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a guaranteed win feature in Weingardt's pari-mutuel gambling method to increase participation in the game.

Claims 2, 21 & 38: Walker '477 describes a lottery system in which at least one token (a ticket) is selected and the player holding that token is awarded a predetermine prize. (Col 11, 56-65) Lotteries are an immensely popular form of gaming. It would have been obvious to one of ordinary skill in the art at the time of the invention to have adapted Weingardt's pari-mutuel system to lotteries in order to take advantage of this popularity.

Claims 3, 22, 39: Weingardt discloses a method of determining the value of the token by dividing the value of the pari-mutuel pool by the number of outstanding tokens. (Col 12, 25-69) Weingardt also discloses that cash awards (the pari-mutuel pool) for Bingo are predetermined. (Col 13, 55-60)

Claims 4, 23 & 40: Weingardt discloses redeeming accrued credits. (Col 3, 39-40)

Claims 5, 24 & 41: Weingardt discloses that the pari-mutuel pool may comprise the set of all tokens awarded to all players. (Col 1, 39-41)

Claims 6, 25 & 42: Weingardt describes playing poker for table stakes. (Col 14, 60-64) When playing for table stakes, the set of tokens (money, chips, etc.) comprises the tokens awarded within a defined time limit – i.e., at the beginning of the game.

Claim 7: Weingardt discloses account initialization. (Col 7, 55-67)

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Claims 8, 26 & 43: Walker '477 discloses periodic drawings (Col 13, 1-2) and thus the conversion of tokens at the expiry of a predetermined time period – in this case, twice a week. Lotteries typically have periodic drawings and it would have been obvious to one of ordinary skill in the art at the time of the invention to have periodic lottery drawings to conform to customary practices in the industry.

Claims 10, 27 & 44: Weingardt discloses, sports betting on horse races (Col 1, 25-29), video poker (Col 3, 5), slot machines (Col 3, 12), blackjack, (Col 3, 12) and bingo (Col 13, 55). Walker '477 discloses a lottery game that is essentially keno. (Col 12, 63 through Col 13, 6). Weingardt discloses that pari-mutuel gambling may be used in connection with any number of games and that doing so would make the games comply with state and federal regulations. (Col 1, 13-20) While neither reference specifically teaches solitaire, it would have been obvious to one of ordinary skill in the art at the time of the invention to apply pari-mutuel rules to that game to make it comply with state and federal regulation.

Claims 11, 28 & 45: Weingardt discloses various casino games. (Col 3, 5-13) Weingardt does not, however, teach the concept of a guaranteed win or statistically positive token return. Walker '477, an analogous invention, teaches that providing a guaranteed win increases participation in the game. (Col 3, 28-32)

It would have been obvious to one of ordinary skill in the art at the time of the invention to include a guaranteed win feature in Weingardt's pari-mutuel gambling method to increase participation in the game.

Claims 12, 13, 29, 30, 46 & 47: Weingardt discloses conversion of tokens after a predetermined number of definable units of game play. (Col 7, 43-49) Weingardt discloses that after each hand or game, the amount of the player's winnings may be added to the credit meter. Players can cash out at any time. (Col 8, 3-10)

Claims 16, 33 & 50: Weingardt discloses a computer network. (Col 7, 22-26)

Claims 17, 34 & 51: While Weingardt discloses electronically linking the gaming devices in a conventional manner to a central computer, Weingardt does not specifically disclose use of the Internet. The Internet is, however, a well-known and conventional manner for linking computers. Walker '477 (Col 7, 57) discloses use of the Internet to link gaming devices with a central computer. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the Internet to link gaming devices to a central computer because this is a well-known and conventional manner of linking computers.

Claims 18, 35 & 52: Weingardt discloses a game machine. (Col 7, 14)

Claims 19 & 36: While Weingardt is primarily concerned with electronic gaming devices, it does discuss use of pari-mutuel wagering in traditional poker games in which there is a human dealer. (Col 14, 60-61)

7. Claims 14, 15, 31, 32, 48 & 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weingardt in view of Walker '477 as applied to claims 1, 20, & 37 above, (as appropriate) and further in view of Walker et al. (US Patent No. 6277972). (Henceforth, Walker '972.)

Claim 14, 31 & 48: Weingardt and Walker '477 disclose the invention substantially as claimed. Weingardt discloses token accounts lasting through multiple games or gaming

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sessions (Col 16, 17-23), but does not disclose an account that allows the player to leave the casino and come back at some later date. Walker '972, an analogous invention, discloses such an account and teaches that such accounts encourage repeat visits to the casino. (Col 3, 13-27) It would have been obvious to one of ordinary skill in the art at the time of the invention to provide accounts that allow the player to leave the casino and return at a later date in order to encourage repeat visits by the player.

Claims 15, 32 & 49: Weingardt and Walker '477 describe the invention substantially as claimed. These references do not, however, disclose the concept of expiring tokens.

Walker '972 discloses expiring tokens. Walker '972 teaches that having expiring game tokens gives the player the incentive to make return visits to the casino. (See Abstract.) It would have been obvious to one of ordinary skill in the art at the time of the invention to include expiring tokens in order to give players incentives to make return visits to the casino.

8. Applicant's arguments filed 11 June 02 have been fully considered but they are not persuasive.

a. Applicant has overcome the objections under 37 CFR 1.71 regarding the term "positive return" by amendment. That objection is hereby canceled. However, the objection under 37 CFR 1.71 concerning changing the odds in order to ensure a "statistically positive token return" (which Examiner interprets to mean "more tokens that the player bought") to the player remains in force and will be discussed in connection with the claim rejections under 35 USC §112 below.

b. Applicant argues that the rejection of claims 10, 11, 19, 27, 28, 36, 44 & 45 under 35 USC §112 was improper. Applicant has pointed to a number of changes made to games that may ensure that players in general have a statistically positive token return, but none of these changes can ensure that any one player has a statistically positive token return. Applicant's disclosure makes it plain that each and every player should gain a statistically positive token return.

On page 1, Applicant's specification states, "The present invention is related to gambling, and more particularly to a gambling model that yields a net positive result for the player." Note that the specification says, "the player" – not "the players" or "the player's as a group". The specification speaks in terms of attracting a player because the player will receive a positive return. Yet none of applicant's changes to the games listed can guarantee that a particular player will have such a positive return. While players in general may, for instance, receive a positive return at the craps table, Applicant has failed to disclose a method for preventing a particular player from losing his shirt. The same applies to each of the games listed.

Applicant argues that Weingardt and Walker '447 fail to teach a statistically positive token return to the players. Examiner disagrees. Weingardt teaches the concept of tokens with values that vary depending on the number of tokens issued. Walker '447 teaches each player receiving a statistically positive token return – i.e., more tokens than the player initially purchased. Walker '447 teaches that providing a guaranteed win increases participation in the game. (Col 3, 28-32)

As noted above, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a guaranteed win feature in Weingardt's pari-mutuel gambling method to increase participation in the game.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Marshall Fey, *Slot Machines, A Pictorial History of the First 100 Years*, show a number of slot machines with a statistically positive token return. Kamille (US Patent Number 5,855,514) is another game with a guaranteed winner.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (703) 305-3319. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

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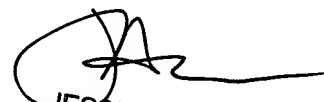
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.



cbc

August 26, 2002



JESSICA HARRISON
PRIMARY EXAMINER